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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Compunitix, Inc.

Serial No. 75373093

Ansel M. Schwartz, Esq. for Compunitix, Inc.

John M. Gartner, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney).

Before Walters, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Compunitix, Inc. has filed an application to register
the mark MINUET on the Principal Register for "multiple
point control units for multimedia, audio or video
conferencing, namely conferencing bridges," in International
Class 9.¹

¹ Serial No. 75373093, filed October 14, 1997, based on an allegation of
a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark MINUET, previously registered for "computer software, namely, a communications program to automatically distribute calls,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d

² Registration No. 2,263,615 issued July 20, 1999, to Cintech Tele-Management Systems, Inc.

1098, 192 USPQ 24, 29 (CCPA 1976). See, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The marks in this case are identical. It is well established that when the marks at issue are the same or nearly so, the goods in question do not have to be identical to find that confusion is likely. As we stated in *In re Concordia International Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983), "... the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion." It is sufficient that the goods are related in some manner and that their character or the circumstances surrounding their marketing are such that they are likely to be encountered by the same people in situations that would give rise to the mistaken belief that the producer was the same. *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Regarding the goods, the Examining Attorney contends that both marks are used to identify telecommunications devices; that both identifications of goods are broadly worded with no limitations and, therefore, the channels of trade are the same; that, even if the purchasers of the

respective products are sophisticated, such purchasers are not immune from trademark confusion.

In support of his position, the Examining Attorney submitted copies of another registration owned by applicant and two third-party registrations. The identification of goods in Registration No. 2,355,738, owned by this applicant for the mark CONTEXSPAN, is "telecommunication hardware and software for linking bridges for conferencing."

One of the third-party registrations submitted by the Examining Attorney, No. 2,085,869 includes in its identification of goods: "... **video, audio and related equipment in the areas of telecommunications, namely,** analog codecs, ... PC-screen projectors, cameras, microphones, video cards, video monitors, ... **multipoint video and audio conference bridges,** and analog and digital voice, data, image, and video switches." The identification of goods in the other third-party registration, No. 2,469,125, is "**telecommunications hardware, namely,** telephones that operate using a connectionless protocol, power supplies for such telephones, **conference bridges,** adapters for telephones and facsimile machines that convert a connectionless protocol to analog transmission, and **software for** call processing, voice mail, and **calling features, namely,** call hold, call wait, call forward, and **conference.**" (*Emphasis added.*)

Applicant begins its argument that the goods are different with the assumption that the registrant's goods are limited to "software for phone calls by general customers in homes, buildings, etc. since there is no indication of any specific market channel." Applicant contends that its products, on the other hand, are directed to "corporations having enough employees to purchase a dedicated conferencing bridge so they do not have to utilize conferencing services offered by companies such as AT&T or MCI." (Brief, p. 3.) Applicant states that its goods apply only to more than two-party calls; that its units are expensive, costing approximately \$50,000 apiece; that the trade channels for its goods and the registrant's goods are different because applicant sells only to end-users through direct sales by a sales person, whereas registrant's customers purchase the software on disk; and that the purchasers of applicant's goods are knowledgeable, sophisticated purchasers, usually with engineering bachelor's degrees or higher degrees. Applicant notes that the purchasers of applicant's goods are not the users who make the phone calls; and that "[t]he software associated with the registration is for the purpose of distributing calls[,] [that] 'distributing' means 'to spread out[,]'" [whereas applicant's] goods are for the purpose of bringing

together three or more parties to a telephone or video call." (Brief, pp. 4-5.)

The question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Applicant's own prior registration contains both hardware and software for linking bridges for conferencing. The identification of goods in the cited registration contains no limitations and, thus, contrary to applicant's assumptions and contentions, registrant's software is not limited to distributing two-party calls, nor is it limited to being disseminated on diskettes to individual end-users. Rather, the broad identification of goods in the registration encompasses all types of computer software for automatically distributing calls, from a low-end basic product to expensive software. We see from applicant's own prior registration that linking bridges for conferencing involves both hardware and software. We find this record

sufficient to conclude that the products are sufficiently related that, if identified by identical marks, confusion as to source is likely.

Moreover, the broad identifications of goods in both the application and the cited registration means that both products are distributed through all normal trade channels for such products to all usual purchasers thereof, and there is likely to be overlap. The fact that some set of purchasers of both applicant's and registrant's products may be knowledgeable, sophisticated purchasers does not mean that they are immune from trademark confusion.

Therefore, we conclude that in view of the identity of the marks herein, their contemporaneous use on the related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Further, applicant, as the newcomer, has both the opportunity and the obligation to avoid confusion. While we have no doubt in this case, we point out that we are obligated to resolve any doubt that confusion is likely in favor of the registrant. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988).

Decision: The refusal under Section 2(d) of the Act is affirmed.